

Pre-Appeal Brief Request For Review

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Serial No.: 10/632,070

Filed 31 July 2003

For: TEARABLE ELASTIC COMPOSITE ARTICLE AND METHOD OF MANUFACTURE

WO 95/06449 teaches elastic wraps wherein perforations are made in the elastic wrap, e.g., by a rotary die having a serrated perforator blade or by laser perforation (specification, page 17, lines 1-7). That is, the laminated composites of WO 95/06449 that include elastic filaments are perforated after the composites are laminated (e.g., after elastic filaments are bound to nonwoven web (WO 95/06449, page 10, lines 12-13)).

Because the laminated composites of WO 95/06449 are perforated after the composites are laminated, elastic filaments in the WO 95/06449 composites are severed as a result of the perforation process as demonstrated by, e.g., the reductions in tensile strength and % elongation of the perforated samples as compared to the unperforated controls of the examples discussed in WO 95/06449 (see, e.g., Tables 2-6, pp. 23-27 of WO 95/06449).

As support for this anticipation rejection, it is asserted that "there will be elastic filaments in the unperforated areas that are not severed and these filaments would extend continuously along the length of the article." (Final Office Action, page 3, lines 6-9). No basis in fact or reasoning was, however, provided to show that it is inherent that there will be elastic filaments in the unperforated areas that are not severed and that these unsevered filaments would extend continuously along the length of the article.

As a result, the requirements for a proper 35 U.S.C. §102 rejection based on inherent characteristics of the composites of WO 95/06449 have not been met. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. §2112(IV), page 2100-54, 8th ed., Rev. 2 (May, 2004) (emphasis in original). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

There is, however, no discussion in the Office Action regarding why or how the articles of WO 95/06449 inherently meet the limitations recited in the rejected claims. The rejection is, instead, based on an unsupported assertion. Thus, the requirements for anticipation based on inherency have not been met with respect to independent claims 1 and 18.

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For at least the above reasons, Appellants assert that clear errors exist in the anticipation rejection of independent claims 1-4, 7-12, and 15-18 in view of WO 95/06449. Review and withdrawal of this rejection are respectfully requested.

Claims 6 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over WO 95/06449. As discussed above, WO 95/06449 fails to teach each element of claim 1, from which claims 6 and 14 directly or ultimately depend. A case of *prima facie* obviousness requires that the all the recited elements are taught or suggested by the cited references and that some motivation or suggestion be provided that would lead one of ordinary skill in the art to make the asserted modification to reach the claimed invention. Neither of those requirements have been with respect to the obviousness rejection of claims 6 and 14 base on WO 95/06449 alone. Appellants thus submit that a proper case of *prima facie* obviousness has not been established for claims 6 & 14. Review and withdrawal of this rejection are respectfully requested.

Claims 1-6, 8-12, 14, 16-18, 42, and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hansen et al. (U.S. Patent No. 4,984,584) in view of Swanson et al. (U.S. Patent No. 6,383,958 B1). Appellants disagree and submit that this rejection fails to provide one or more of the essential elements needed for a *prima facie* obviousness rejection.

A proper *prima facie* case of obviousness requires, *inter alia*, identification of a motivation to combine/modify the cited references and a showing that the proposed combination provides a reasonable expectation of success. M.P.E.P. § 2143. These requirements have not been met with respect to this obviousness rejection.

Hansen et al. teach a high elastic modulus, cohesive compression bandage that provides joint support (Hansen et al., abstract). As admitted in the non-final Office Action mailed February 25, 2005 (page 4, paragraph 10), the bandages of Hansen et al. do not include tear lines, nor is there any discussion in Hansen et al. regarding tearability of the bandages. Swanson et al. provide nonwoven sheets that may include embossed patterns to enhance tearing properties of the article (Swanson et al., abstract).

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In support of this rejection, it is asserted that modifying the laminated elastic composites of Hanson et al. to include the embossed sheets of Swanson et al. will result in a tearable elastic composite structure. No evidence or reasoning has, however, been provided as to why or how a person of ordinary skill would reasonably expect or know that the combination would work, i.e., that the result would be a tearable elastic composite article. Swanson et al. does not teach or suggest that the tearability of its embossed nonwoven sheets would survive lamination in composite that includes elastic filaments as disclosed in Hansen et al. Nor does the Office Action contain any reasoning as to why the elastic filaments would not destroy the tearability provided by the embossed patterns of Swanson et al.

In view of the above, Appellants submit that this rejection is the result of impermissible hindsight reconstruction. In setting forth an obviousness rejection, one cannot "simply engage in a hindsight reconstruction of the claimed invention, using the Appellant's structure as a template and selecting elements from references to fill the gaps." *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). Further, both the suggestion for combining the teachings of the prior art to make the invention and the reasonable likelihood of its success must be founded in the prior art and not in the teachings of Appellants' disclosure. *In re Dow Chem.*, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Here, the cited art neither suggests the proposed modification/combination nor does the art or the Office Action provide any basis for a reasonable expectation that the proposed modification/combination would result in a tearable elastic composite.

In addition to the above error in this obviousness rejection, Appellants have noted before that the bandages of Hansen et al. are directed to providing joint support without undue constriction, and providing compressive force to support ligaments and flexor tendons, e.g., in the leg of a horse (Hansen et al., abstract). Tear lines, such as provided by embossed patterns in the articles of Swanson et al., would be disadvantageous to the bandages of Hansen et al., as they would likely provide a weakened bandage that would not supply adequate support to the joint, and may even separate under the stress of use. Because the asserted combination/motivation of introducing tear lines into the compression bandages of Hansen et al. could be expected to render the bandages unsuitable for their intended purpose, Appellants respectfully assert that the art

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does not suggest the desirability to combine the references; thus provides no motivation sufficient to support a case of *prima facie* obviousness.

It is asserted, however, that Swanson et al. disclose a strong product with "acceptable" tensile strength that may be used throughout the health care and athletics fields (Swanson et al., abstract and col. 16, lines 36-56), and that providing the primary reference's product (Hansen et al.) with the tear line structure of the secondary reference (Swanson et al.) would not result in a product unsuitable for its intended use. Appellants respectfully disagree. While the articles of Swanson et al. may provide acceptable tensile strength for an adhesive article that exhibits enhanced tear characteristics, there is no suggestion that the same level of tensile strength would be acceptable for the compression bandages of Hansen et al.

For at least these reasons, review and withdrawal of the obviousness rejection of claims 1-6, 8-12, 14, 16-18, 42 and 43 over Hansen et al. in view of Swanson et al. are requested.

Summary

For at least the foregoing reasons, Appellants respectfully request that the Panel review and reverse the final rejections of claims 1-12, 14-18, 42, and 43 in the above-identified application, and that a Panel Decision allowing the application on the existing claims be issued.

CERTIFICATE UNDER 37 C.F.R. 1.8:
The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this <u>11th</u> day of <u>October</u> , 2005, at <u>1:34 p.m.</u> (Central Time).
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